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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,193	05/23/2000	Kia Silverbrook	NPB001US	9142

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/575,193

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

Khanh H. Le

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1- 2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, 61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1- 2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/13/04;02/07/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Detailed Action**

1. This Office Action is in response to the correspondence received January 05, 2005. Claims 1- 2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, 61 are pending. Claims 1, 26 and 31 are independent. All amendments to the claims and the specifications have been entered.

### **Response to Arguments**

2. In view of the amendments the previous rejections are withdrawn.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. **Claims 1- 2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Intelligent Paper” by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406, herein “Intelligent Paper”.**

As to claims 1 , 61, 26, 31

Intelligent Paper discloses

A system for providing printed information to a user from a DB storage device the system including:

a user printer module connected to the network, for interfacing the user with the system, the module being responsive to the user requesting first information from the first DB for generating a first printed medium that displays the first information in visible ink (see Intelligent

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Paper p. 392-393:interpreted as the Intelligent Paper is printed with content in visible ink by a party for sale to consumers. All other claimed components are implicitly present in INTELLIGENT PAPER).

providing the first printed media with an identifier in invisible ink such that designation of the identifier by the user using a reader interface module results in the reader interface module communicating a request for second information (INTELLIGENT PAPER pages . 399-401 discloses linking to on-line providers for more information);

such that the printer generates a second printed medium carrying said second information (Intelligent Paper discloses at page 404, 2<sup>nd</sup> full paragraph that a user peripheral used to receive the linked information after pointing on the intelligent paper is a printer. Thus INTELLIGENT PAPER implicitly discloses a second printed medium can be obtained, via this printer, displaying the second information, obtained from clicking on an identifier on the first printed medium).

account means for calculating, providing payments to the first party controlling the 1<sup>st</sup> DB by the second party controlling the second DB (Intelligent Paper at p. 399-401 discloses linking to on-line content providers for more information (interpreted as ads or content or commercial transactions information).

Official Notice is taken that it is well-known parties referring potential consumers to commercial websites get rewarded by the websites owners. Thus it would have been obvious to one skilled in the art at the time of the invention to add this well-known referral commissions feature (the second party paying the first party for the referral )to INTELLIGENT PAPER to allow e-commerce commissions sharing in the networked INTELLIGENT PAPER context as has been done in other e-commerce contexts.

As to claims 2, 32, 33,

INTELLIGENT PAPER implicitly discloses many printers and user modules .

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As discussed above, referral commissions sharing in the networked INTELLIGENT PAPER context, are obvious.

Further, INTELLIGENT PAPER does not specifically disclose calculating payments which are proportional to the number of media printed by the module(s) which display first, second or third information.

However, Official Notice was taken that it is well-known that referral commissions are based on the number of referrals or exposures to the ads, which in the context of printed ads would be determined by the number of printed sheets containing the ads.

Thus it would have been obvious to one skilled in the art at the time of the invention to add this conventional billing feature to the Intelligent Paper scheme to compensate the on-line referring party.

As to claims 4, 34 :

The claimed types of payments/accounts are ordinary and well-known types and thus it would have been obvious to one skilled in the art at the time of the invention to add to Intelligent Paper to facilitate accounting among parties.

As to claim 5, Intelligent Paper does not disclose a fixed payment for a predetermined period

However Official Notice was taken that it is well-known payment as fixed amounts per fixed periods are common commercial service contract terms used for simplicity thus it would have been obvious to one skilled in the art at the time of the invention to add such feature to the scheme of Intelligent Paper in order to achieve the above mentioned advantage .

As to claims 7, and 37, Official Notice is taken that payment to the referring party based on the value and /or quantity of the goods/services ordered is well-known thus one skilled in the art at the time of the invention would have known to add such to INTELLIGENT PAPER to

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carry out conventional referral schemes in the INTELLIGENT PAPER context of many connected vendors.

As to claim 11, INTELLIGENT PAPER discloses wherein a plurality of identifiers are spaced part on the respective printed medium (see at least page 393 last paragraph).

As to claims 15, and 45, Official Notice is taken that it is well-known that it is well-known to monitor payment and to disallow continuation of service for non-payment after a certain predetermined (e.g. grace) period. It would have been obvious to one skilled in the art at the time the invention was made to add such feature into INTELLIGENT PAPER to enforce such policy and arrive at the claimed feature of generating a disable signal if the payment from the 2<sup>nd</sup> party is not settled within a predetermined time, the generation of the disable signal preventing the module obtaining the 1<sup>st</sup> or 2<sup>nd</sup> information.

As to claim 18 (dependent on claim 1): Intelligent Paper at pages 400-401 discloses linked commercial transactions. It is thus interpreted that links to a vendor's further information or instructions for ordering goods and services (3rd information) are involved in INTELLIGENT PAPER.

### Conclusion

5. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

June 24, 2004

  
KHL

  
JAMES W. MYHRE  
PRIMARY EXAMINER